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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,980	12/27/2000	Elaine Lee	8600-0010	6822

7590 09/20/2007  
ROBINS AND PASTERNAK LLP  
1731 EMBARCADERO ROAD, SUITE 230  
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EXAMINER
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PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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09/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/749,980

Applicant(s)

LEE, ELAINE

Examiner

Michael B. Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-11,14-16,19,22-24,31,32 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,22,31,32 and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 7-11, 14-16, 19, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 8, 11, 19, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz (US Patent Number 5,957,971). Schwartz discloses a vaso-occlusive coil for treating aneurysms having a fibrin/thrombus-stabilizing molecule, e.g. Factor XIII, bioactive coating (see various. embodiments disclosed in figures 1-3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US Patent Number 5,957,971) in view of Schwarz et al. (US Patent Number 4,414,976) (cited by examiner on 892, paper number 04222004).

Schwartz discloses the claimed invention except the thrombus-stabilizing molecule being plasminogen activator inhibitor or plasmin inhibitor Schwarz teaches

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that tissue adhesive for use in vascular surgery may be made with Factor XIII, plasminogen activator inhibitor or plasmin inhibitor in order to stimulate wound healing (Column 1 lines 37-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Schwartz with the thrombus-stabilizing molecule being plasminogen activator inhibitor or plasmin inhibitor, in view of Schwarz, in order to promote healing.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US Patent Number 5,957,971) in view of Slaikou et al. (US Patent Number 6,231,590) (cited by examiner on 892, paper number 16).

Schwartz discloses the claimed invention except for the member being plasma-treated. Slaikou teaches that devices are plasma treated in order to attract platelets and thrombogenic proteins to the device (Column 4 lines 57-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Schwartz, with a plasma treatment, in view of Slaikou et al., in order to attract platelets and thrombogenic proteins and thus promote healing at the implantation site.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over unpatentable over Schwartz (US Patent Number 5,957,971) in view of Murayama et al. (US Patent Number 5,891,192) (previously cited by examiner).

Schwartz discloses the claimed invention except for the vaso-occlusive member being subjected to ion-implantation. Murayama et al. teach that ion implantation is used

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to alter the surface properties, such as thrombogenicity and endothelial cellular migration and adhesion, of the device (Column 3 lines 21-29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Schwartz with ion-implantation in view of Murayama et al., in order to alter the thrombogenicity and endothelial cellular migration and adhesion.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz (US Patent Number 5,957,971) in view of Nikolchev et al. (US Patent Number 6,526,979) (cited by examiner on 892, paper number 16).

Schwartz discloses the claimed invention except for the vaso-occlusive member being microtextured. Nikolchev discloses that an occlusive member is microtextured in order to promote tissue ingrowth and enhance the occlusion of the vessel (Column 14 lines 9-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Schwartz with the microtexturing in view of Nikolchev, in order to enhance tissue ingrowth and occlude the vessel.

### ***Response to Arguments***

Applicant's arguments filed 07/02/2007 have been fully considered but they are not persuasive. Applicant has argued that Schwartz '971 is entirely silent as to vaso-occlusive devices but instead teaches a stent. The Examiner maintains that Schwartz teaches a coil member intended to be implanted into the vasculature of a patient and

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capable of vaso-occlusion. The Applicant has failed to structurally distinguish the present invention from that of the prior art device of Schwartz.

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Schwartz which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant's remarks concerning the rejections under 35 U.S.C. 103(a) are reiterations of Applicant's arguments against the Schwartz reference and are believed addressed by the above remarks.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy  
*Michael B. Priddy*  
September 14, 2007

*[Signature]*  
EDUARDO F. ROBERT  
SUPERVISORY PATENT EXAMINER